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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

YAGOUBZADEH LAW FIRM
LLP, a California Limited Liability
Partnership;

Plaintiff,

v.

ULISES PIZANO-DIAZ,
Defendant.

Case No.: 2:23-cv-08299-GW-MAR

**DEFENDANTS REPLY TO
PLAINTIFF'S OPPOSITION TO
DEFENDANT'S MOTION FOR
SUMMARY JUDGMENT**

Hearing Date: **December 12, 2024**
Time: **8:30 a.m.**
Judge: **Hon. George H. Wu**

I. Summary of Defendant Argument

Defendant respectfully argues that that Plaintiff's Complaint should be dismissed summarily because there exists no likelihood of confusion between Plaintiff's registration, 1-800-LUCHADOR, reg. no. 6920485 (Plaintiff's Registration") and Defendant LUCHADOR-formative marks, specifically: 1) ABOGADOR LUCHADOR; 2) LUCHADOR LAWYER;

and 3) LL LUCHADOR LAW with the following stylized logo:



(“Defendant’s Marks”) because the word “luchador” translates to “fighter,” which is highly descriptive of *legal service*, which renders the term weak and incapable for acquiring distinctiveness, and there is also a high number competitor’s trademarks that contain the word “fighter” or “fight” (or a foreign language equivalent) in conjunction with offering *legal services* which creates a “crowded field,” which renders each member of the field relatively weak in its ability to prevent use by others in the crowd. Therefore, Defendant respectfully submits that Plaintiff’s mark should either be cancelled entirely or be given only the most narrow breadth of protection as Plaintiff’s Registration “*consists of a merely descriptive term with numerals in the form of an alphanumeric phone number (e.g. 800, 888, 900 followed by a word)....*” See *In re Page*, 51 USPQ2d 1660 (TTAB 1999) (888 PATENTS denied registration for being merely descriptive of patent-related legal services); TMEP §1209.03(l).

II. Defendant’s Reply to Plaintiff’s Response in Opposition

Plaintiff’s Response in Opposition seems to only disagree with Defendant’s Motion for Summary Judgment on two factual issues; however, Plaintiff does not provide any persuasive evidence supporting Plaintiff’s position on either issue.

1) The first issue relates to the translation of “luchador.” While Plaintiff does not dispute the English translation of “luchador” in Plaintiff’s Statement of Genuine Issues of Material Facts in Dispute (*See* Dkt. 36-1, ¶ 5), Plaintiff spends a large portion of Plaintiff’s Response in Opposition offering alternative definitions, and/or arguing that the English translation of “luchador” is different or more

1 culturally nuanced than merely the English word “fighter.”

2 Defendant respectfully submits that these arguments must fail entirely
3 because Plaintiff’s registration certificate for Plaintiff’s Registration mark literally
4 states: “*The English translation of “luchador” in the mark is “fighter.”*” Defendant
5 has provided a copy for the Court’s review. (See 2nd Decl. of Welch, Exhibit A).

6 Further, it was Plaintiff who provided that English translation of “luchador”
7 to the United States Patent and Trademark Office (“USPTO”) when Plaintiff filed
8 Plaintiff’s application. Defendant has also provided the Court with a copy of
9 Plaintiff’s application to show that Plaintiff was the party that provided the USPTO
10 with the statement: “*The English translation of “luchador” in the mark is*
11 “*fighter.*” (See 2nd Decl. of Welch, Exhibit B).

12 Defendant respectfully submits that Plaintiff should be bound to the English
13 translation of “luchador” that Plaintiff provided the USPTO and that is set forth in
14 Plaintiff’s Registration. Defendant further submits that any evidence of alternative
15 or more culturally nuanced translations of “luchador” is irrelevant, and therefore,
16 unpersuasive to this case at hand as Plaintiff’s case is based on Plaintiff’s
17 Registration, which clearly sets forth the proper English translation of “luchador.”

18 2) The second issue is whether or not the word “fighter” is descriptive of *legal*
19 *services*. Unlike the first issue, Plaintiff did dispute Defendant’s claim that the
20 word “fighter” is highly descriptive of *legal services* in Plaintiff’s Statement of
21 Genuine Issues of Material Facts in Dispute. (See Dkt. 36-1, ¶ 6). However,
22 Plaintiff failed to provide any evidence relevant to this issue.

23 Plaintiff purported provide relevant evidence in the form of Exhibits A
24 through D to the Declaration of Omid E. Khalifeh; however, it appears that the
25 exhibits are only relevant to the first issue, namely, the issue of whether the proper
26 English translation of “luchador” is “fighter.” (See Dkt. 36-1, ¶6).

27 Specifically, Exhibit A is a translation of “luchador” obtained from Collins
28 Spanish-English Dictionary; Exhibit B is a translation of “luchador” obtained from

1 Google; Exhibit C is the registration certificates of third-party trademarks that
2 contain the words “DEFENSOR” and “DEFENSORES (which Plaintiff argues are
3 examples of Spanish words that “better aligned” with legal advocacy); and Exhibit
4 D is a definition of the word “fighter” obtained from Merriam-Webster dictionary.

5 All these exhibits are all essentially challenging the translation of the word
6 “luchador,” which is a separate issue from whether or not the word “fighter” is
7 descriptive of *legal services*.

8 As such, Defendant respectfully submits that Plaintiff has failed to provide
9 any evidence relevant to the disputed issue of whether or not the word “fighter” is
10 highly descriptive of legal services; therefore, Plaintiff’s claim that item no. 6 of
11 Plaintiff’s Statement of Genuine Issues of Material Fact in Dispute is, in fact,
12 “Disputed” is nothing more than a bald conclusory statement.

13 Whereas, in contrast, Defendant has provided multiple different kinds of
14 evidence supporting Defendants position that the word “fighter” is highly
15 descriptive of *legal services*.

16 **A. The Examining Attorney Searched the USPTO Database of**
17 **Registered and Pending Marks and Has Found No Conflicting Marks That**
18 **Would Bar Registration of Defendant’s Marks.**

19 Since the Defendant filed this Motion for Summary Judgment on November
20 14, 2024, all three of Defendant’s federal trademark applications for Defendant’s
21 Marks (application serial nos. 98527115, 98527093, and 98527171) have received
22 a first Office Action from the USPTO. In each case, the examining attorney began
23 the Office Action with the following language:

24
25 “The trademark examining attorney has searched the USPTO database of
26 registered and pending marks and has found no conflicting marks that would bar
27 registration under Trademark Act Section 2(d). 15 U.S.C. §1052(d); TMEP
28 §704.02.”

The USPTO examining attorney is fully aware of Plaintiff’s Registration as

1 it is in the USPTO database, which means, in the opinion of the USPTO examining
2 attorney, there exist no likelihood of confusion between Plaintiff's Registration and
3 Defendant's Marks. Defendant has provided those Office Actions for the Court
4 review (See 2nd Decl. of Welch, Exs. C, D, and E).

5 **B. There Exists Many Competitors That Use the Terms "Fighter" or**
6 **"Fight" in Either Federally Registered Trademarks or at Common Law in**
7 **Conjunction with an Offering of Legal Services.**

8 A useful way to test whether a designation is descriptive or suggestive is to
9 determine the extent to which other sellers have used the designation on similar
10 goods and services. If others are in fact using the term to describe their goods or
11 services, an inference of descriptiveness can be drawn. *De Walt, Inc. v. Magna*
12 *Power Tool Corp.*, 48 C.C.P.A. 909, 289 F.2d 656, 659, 129 U.S.P.Q. 275 (1961)
13 (evidence of opposer's descriptive usage of POWER SHOP for saws regarded was
14 important in determining that the term was descriptive); *Quaker State Oil Refining*
15 *Corp. v. Quaker Oil Corp.*, 59 C.C.P.A. 764, 453 F.2d 1296, 1299, 172 U.S.P.Q.
16 361 (1972) (significant and continuous descriptive use by another rebuts claim of
17 distinctiveness); *The Firestone Tire & Rubber Company v. the Goodyear Tire &*
18 *Rubber Company*, 186 U.S.P.Q. 557, 1975 WL 20835 (T.T.A.B. 1975), aff'd, 189
19 U.S.P.Q. 348, 1976 WL 21295 (C.C.P.A. 1976) (where others in industry do not
20 use the term as a descriptive reference, this is evidence that the term is neither a
21 natural nor obvious way to describe the goods).

22 In the instant case, there is an extremely large number of competitors that
23 use the word "fighter" or "fight" in advertising of *legal services* throughout the
24 entire country. Defendant provides evidence of this widespread use among
25 competitors in both Defendant's First Declaration of Welch, Exhibit B, featuring
26 over 50 federal trademark registrations that include the words "fighter" or "fight"
27 in conjunction with *legal services*, and Defendant's Second Declaration of Welch,
28 Exhibits F through N, featuring the websites of numerous competitors that use the

1 words “fighter” or “fight” in conjunction with offering *legal services* at common
2 law. (See 2nd Decl. of Welch, Ex. F through N). In fact, two such examples,
3 LUCHADORES LEGALES and El LUCHADORE LEGAL, even use the
4 descriptive term in its untranslated form. (See 2nd Decl. of Welch, Exs. M and N).

5 Defendants also offer examples of articles featuring lawyers being
6 complimentarily described as “FRAUD FIGHTER” and “THE FIGHTER.”

7 A mark is merely descriptive if it describes an ingredient, quality,
8 characteristic, function, feature, purpose, or use of an applicant’s goods and/or
9 services. TMEP §1209.01(b); *see, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114
10 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373
11 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re*
12 *Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005)
13 (citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543
14 (1920)).

15 These example articles are celebrating lawyers by calling them “FRAUD
16 FIGHTER” and “THE FIGHTER,” demonstrating that being a “fighter” is a
17 desirable quality or characteristic of a purveyor of *legal services*. Defendant
18 respectfully suggests that such articles are further evidence supporting Defendant’s
19 position that the word “fighter” is highly descriptive of *legal services*.

20 **C. Pursuant to the *Sleekcraft* Factors, Defendant’s Marks Cause No**
21 **Likelihood Consumer Confusion with Plaintiff’s Registration.**

22 Defendant’s respectfully submits that Defendant has provided substantial
23 evidence that word “luchador” (when translated to “fighter” for determining
24 descriptiveness as directed by the Doctrine of Foreign Equivalents) is highly
25 descriptive, and therefore, the strength of Plaintiff’s Registration is very weak,
26 such that Plaintiff’s Registration should either be cancelled entirely or be afforded
27 only the most narrow breadth of exclusive protection (*Sleekcraft* factor 1).

28 And given that fact that each of Defendant’s Marks each contain unique

1 elements not present in Plaintiff's Registration and the common overlapping
2 element, "LUCHADOR," has been determined to be highly descriptive and thus
3 very weak, Defendant respectfully submits the USPTO examining attorney is
4 correct in concluding that Defendant's Marks should be considered sufficiently
5 dissimilar from Plaintiff's Registration to avoid any likelihood of consumer
6 confusion (*Sleekcraft* factor 3).

7 The remaining *Sleekcraft* factors including: (2) proximity of the goods; (4)
8 evidence of actual confusion; (5) marketing channels used; (6) type of goods and
9 the degree of care likely to be exercised by the purchaser; (7) defendant's intent in
10 selecting the mark; and (8) likelihood of expansion of the product lines, are largely
11 irrelevant to the instant determination and/or the parties are largely in agreement.

12 Plaintiff did opine an opposite conclusion than Defendant regarding whether
13 or not *legal services* are likely to be consumed with a high degree of care
14 (*Sleekcraft* factor 6), and Plaintiff made a very weak allegation regarding
15 Defendant's intent in selecting the Defendant's Mark not being bona fide merely
16 because Defendant's selection of Defendant's marks was second in time
17 (*Sleekcraft* factor 7); however, Plaintiff did not provide any supporting evidence
18 for either matter, and, as previously stated, these *Sleekcraft* factors are largely
19 irrelevant to the determination at hand.

20 **D. Because Plaintiff Failed to Provide Any Evidence of Genuine Factual**
21 **Issue in Dispute This Court Can Dismiss Plaintiff Case Summarily.**

22 It takes more than a mere statement that a party is in disagreement to
23 establish a genuine factual issue in dispute. A party must establish some evidence
24 supporting the basis of the dispute. The moving party may carry its burden of
25 production on summary judgment either by "showing" the opposing party *does not*
26 *have enough evidence* of an essential element of its claim or defense to carry its
27 ultimate burden of persuasion at trial. *Nissan Fire & Marine Ins. Co., Ltd. v. Fritz*
28 *Cos., Inc.* (9th Cir. 2000) 210 F3d 1099, 1102. While the Ninth Circuit reviews

1 likelihood of confusion on appeal as a factual issue, this does “not preclude the
2 district court from determining likelihood of confusion as a matter of law, either
3 through dismissal [on a Fed. R. Civ. P. 12(b)(6) motion] or summary judgment.
4 *Murray v. Cable Nat. Broadcasting Co.*, 86 F.3d 858, 24 Media L. Rep. (BNA)
5 2053, 39 U.S.P.Q.2d 1214 (9th Cir. 1996), as amended, (Aug. 6, 1996).

6 In the instant case, Plaintiff disputes that the word “fighter” is highly
7 descriptive of *legal services* in Plaintiff’s Statement of Genuine Issues of Material
8 Facts in Dispute but provides no persuasive evidence relevant to the question of the
9 descriptiveness of the word “fighter” in relation to *legal services*; whereas,
10 Defendant provides substantial evidence that multiple members of the legal
11 community routinely use the term “fighter” or “fight” to describe their *legals*
12 *services*, and that the USPTO trademark examiner does not believe there exists a
13 likelihood of confusing between Plaintiff’s Registration and Defendant’s Marks,
14 and that being a “fighter” is perceived as an admirable quality or characteristic of a
15 purveyor of *legal services*.

16 **III. Conclusion**

17 Accordingly, Defendant respectfully requests this Court grant Defendant
18 Motion for Summary Judgment and dismisses Plaintiff’s case in its entirety with
19 prejudice.

20 Dated this 2nd day of December 2024

21 By: /s/Kevin M Welch/

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